In accordance with the requirements of 37 C.F.R. § 1.121, the attached Appendix shows the changes that have been made by the proposed amendments.

Remarks

I. Status of Claims

Claims 1-160 are pending in this application. Claims 1-120 and 152-155 have been withdrawn from consideration by the Examiner.

Claim 121 has been amended to more clearly describe the claimed invention. Specifically, the claim has been amended to recite that the inventive composition is a heat-activated composition. Support for this amendment can be found throughout the application as originally filed, such as, for example, at page 4, lines 20-21, page 5, 16-17, page 9, lines 13-14, and line 22 - page 10, line 1, and Examples 1-9.

Claims 156-160 have been added. Support for these claims can be found throughout the application as originally filed, such as, for example, at original claim 151, now cancelled, and at page 5, lines 9-10; at page 7, lines 6-16, and Examples 1-9.

Accordingly, since it was clear from the specification that the compositions of the invention required heat activation, these amendments only explicitly state what was implicitly understood to be the scope of the claims in view of the specification. Thus, these amendments in no way narrow the scope of the amended claims, nor do they add new matter.

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II. Rejections under 35 U.S.C. § 112, second paragraph

Claim 151

Claim 151 has been rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth on pages 3-4 of the present Office Action.

First, the Examiner asserts that "the specification, while being enabling for heat activating the hair or keratin fibers, does not reasonably provide enablement for a heat-activated composition." *See* page 3 of the present Office Action. Applicants do not understand what the Examiner means by "heat activating the hair or keratin fibers." Regardless, Applicants disagree with this rejection. As defined at page 7 of the present specification, a "heat-activated" composition refers to a composition which, for example, shapes and/or retains the shape of at least one keratinous fiber better than the same composition which is not heated during or after application of the composition. According to the present invention, the at least one keratin fiber is heated during or after the application of the inventive composition, but the at least one keratin fiber is not heat-activated as presently defined.

The Examiner also asserts that the "specification does not provide any guidance or description as to heating the composition at elevated temperatures, during or after the application of the composition." *See* page 4 of the present Office Action. Applicants disagree. In fact, the Examiner herself acknowledges such methods - she asserts that "the only method of heat activating described on page 7, lines 6-16 is, the use of elevated temperatures...provided either by directly contacting [at least] one keratinous hair fiber with a heat source...or indirectly providing a heat source...." *Id.* As the definition of a "heat-activated" composition explains, the inventive composition is heated

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during or after its application to the at least one keratinous fiber. Thus, when the keratinous fibers are heated, the composition on those keratinous fibers is inherently heated.

The Examiner also asserts that "on page 19 (lines 11-19), the example for treating and measuring the Curl Droop also teaches ironing hair (i.e., heat activating hair), but not heating the composition." *See* page 4 of the present Office Action. Applicants disagree. The procedure described in the cited passage includes the recitation that hair swatches were treated with the inventive composition, blow dried, and then heated with a flat iron for 1 minute. As discussed above, ironing the hair is not heat activating it as defined in the present application - it is merely heating the hair and nothing is "activated" without the inventive composition. Further, the composition is heated according to the above procedure, because the hair is treated with the composition and then heated (e.g.: heated with a flat iron).

The Examiner finally asserts that

> Applicants have not described or suggested any thing in the instant specification that enables one of an ordinary skill in the art to "heat or heat-activate" the composition, what range of temperatures used to heat or the duration of heat activating etc. Absent any guidance as to how to heat-activate the composition, one of ordinary skill in the art would have to perform undue experimentation [in order to] prepare a heat-activated composition, as claimed.

See page 4 of the present Office Action. Applicants disagree.

According to M.P.E.P. § 2164.04, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. The Examiner may do so by making specific findings of fact, supported by evidence, and then drawing conclusions based on these findings of fact. Further, the M.P.E.P. states

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that the Examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually. M.P.E.P. § 2164.08. Finally, not everything necessary to practice the invention need be disclosed. *Id.* In fact, what is well-known is best omitted. *Id.* All that is necessary is that one skilled in the art be able to practice the claimed invention, given the level of knowledge and skill in the art. *Id.*

In the present case, as cited by the Examiner, page 19, lines 11-21 recite a general procedure for making and using the presently claimed heat-activated compositions. Accordingly, this paragraph alone comprises sufficient guidance to enable one of ordinary skill in the art to make and use the inventive compositions. For example, this paragraph recites the weight of solution applied per weight of hair, the apparatus used to heat the hair and composition, the length of time of heating, and the procedure used to determine the heat activation and the durability of the compositions.

Therefore, Applicants submit that there is sufficient guidance for one of skill in the relevant art to make and use the claimed compositions. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claim 121

Claim 121 has been rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth on page 5 of the present Office Action. The Examiner asserts that the phrase "'durable non-permanent shaping', which is indefinite because it is unclear as to how the shaping of the hair could be durable and at the same time non-permanent." *See* page 5 of the present Office Action. Applicants disagree.

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As clearly defined at page 8, "non-permanent shaping" refers to a method of setting keratinous fibers in a particular shape or style which does not comprise breaking and reforming disulfide bonds within a keratinous fiber. Further, as defined at page 7, "durable shaping" refers to holding or keeping a shape of a keratinous fiber until the keratinous fiber is washed with water and/or shampoo. Accordingly, Applicants fail to see how the phrase "non-permanent shaping" is indefinite.

For at least the foregoing reasons, Applicants respectfully request withdrawal of this rejection.

III. Rejections under 35 U.S.C. § 102

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *See* In re Arkley, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

Koga

Claims 121, 135, 137, 138, 140, 141, and 148-150 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,660,838 ("*Koga*") for the reasons set forth on pages 5-6.

Applicants respectfully traverse this rejection, however, in order to expedite the prosecution of the present application, claim 121 has been amended to recite that the inventive composition is heat-activated. *Koga* does not teach, either explicitly or

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impliedly, a heat-activated composition for durable non-permanent shaping or durable retention of a non-permanent shape of at least one keratinous fiber according to the present invention. *Koga* also fails to teach each and every limitation of new claims 156-160.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

Lentini

Claims 121, 130, 131, 133, and 140-150 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,514,367 ("*Lentini*") for the reasons set forth on page 6.

Applicants respectfully traverse this rejection, however, in order to expedite the prosecution of the present application, claim 121 has been amended to recite that the inventive composition is heat-activated. *Lentini* does not teach, either explicitly or impliedly, a heat-activated composition for durable non-permanent shaping or durable retention of a non-permanent shape of at least one keratinous fiber according to the present invention. *Lentini* also fails to teach each and every limitation of new claims 156-160.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

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WO '009

Claims 121-124, 135, 139-141, and 148-150 have been rejected under 35 U.S.C. § 102(b) as being anticipated by WO 99/24009 ("*WO '009*") for the reasons set forth on page 6.

Applicants respectfully traverse this rejection, however, in order to expedite the prosecution of the present application, claim 121 has been amended to recite that the inventive composition is heat-activated. *WO '009* does not teach, either explicitly or impliedly, a heat-activated composition for durable non-permanent shaping or durable retention of a non-permanent shape of at least one keratinous fiber according to the present invention. *WO '009* also fails to teach each and every limitation of new claims 156-160.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

IV. Rejection under 35 U.S.C. § 103

Beck '483

Claims 121-135, 140, 141, 149, and 150 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2002/0031483 A1 ("*Beck '483*") for the reasons set forth on pages 7-8 of the present Office Action.

Applicants respectfully traverse this rejection, however, in order to expedite the prosecution of the present application, claim 121 has been amended to recite that the inventive composition is heat-activated. *Beck '483* does not teach or suggest a heat-activated composition for durable non-permanent shaping or durable retention of a non-

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permanent shape of at least one keratinous fiber according to the present invention. *Beck '483* also fails to teach or suggest all limitations of new claims 156-160.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

Koga

Claim 151 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,660,838 ("*Koga*") for the reasons set forth on pages 9 of the present Office Action.

Although claim 151 has been deleted, claim 121 has been amended to recite that the inventive composition is heat-activated. Applicants submit that *Koga* does not teach or suggest a heat-activated composition for durable non-permanent shaping or durable retention of a non-permanent shape of at least one keratinous fiber according to the present invention. *Koga* also does not teach or suggest all elements of new claims 156-160.

Koga discloses that its compositions can be used in, inter alia, "hair-care products such as hair treatments." *See* col. 2, line 24. The Examiner admits that "*Koga* does not specifically suggest treating hair with hair driers or blowers or steamers as described in the instant specification." *See* page 9 of the present Office Action. However, the Examiner continues, summarily concluding that "the 'hair treatments of *Koga* include all known methods of hair styling, coloring, and shaping, with and without heat activation of hair." *See* page 9 of the present Office Action.

The Federal Circuit has held that there must be a clear and particular suggestion

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in the prior art to combine the teachings of the cited references in the manner proposed by the Examiner. Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2D (BNA) 1314, 1318 (Fed. Cir. 1996). As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak,* 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

The Examiner can meet the burden of establishing a prima facie case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine,* 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (internal citations omitted) (emphasis added).

On January 18, 2002, the Federal Circuit again reaffirmed the Examiner's high burden to establish a *prima facie* case of obviousness and emphasized the requirement for specificity. In *In re Sang-Su Lee*, the Federal Circuit held that "[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." 277 F.3d 1338, 1433 (Fed. Cir. 2002). Further, the Federal Circuit explained that

> [t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in

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> the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Id. (internal citations and quotation omitted) (emphasis added).

In the present case, Applicants respectfully submit that the requisite objective teaching is not present in the references. Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

JP '656

Claims 121, 135, and 136 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Abstract of JP 08217656 ("*JP '656*") for the reasons set forth on page 10 of the present Office Action.

Applicants respectfully traverse this rejection, however, in order to expedite the prosecution of the present application, claim 121 has been amended to recite that the inventive composition is heat-activated. *JP '656* does not teach or suggest a heat-activated composition for durable non-permanent shaping or durable retention of a non-permanent shape of at least one keratinous fiber according to the present invention, nor does the Examiner offer such a teaching or suggestion. *JP '656* also fails to teach or suggest all limitations of new claims 156-160.

Accordingly, for at least this reason, Applicants respectfully request withdrawal of this rejection.

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V. Nonstatut ry D uble Patenting Rejections

Claims 121-151 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Application No. 09/614,118. *See* page 11 of the present Office Action. Claims 121-151 have also been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-199 of U.S. Application No. 09/820,812. *See* pages 11-12 of the present Office Action.

Applicants disagree and traverse these rejections. At this time, however, Applicants respectfully request that the rejections be held in abeyance until allowable subject matter is indicated in this application.

VI. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Thalia V. Dona, Reg No. 39,064

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Appendix

Version with markings to show changes made pursuant to 37 C.F.R. § 1.121(c)(1)(ii):

IN THE CLAIMS:

--121. (Amended) A composition for durable non-permanent shaping or durable retention of a non-permanent shape of at least one keratinous fiber comprising at least one compound chosen from C_3 to C_5 monosaccharides, wherein said at least one compound is present in an amount effective to impart a durable non-permanent shape to said at least one keratinous fiber or to durably retain a non-permanent shape of said at least one keratinous fiber**, and further wherein said composition is heat-activated**.--

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